

Remarks/Arguments

Claim 1 has been rejected, and Claims 2 to 11 and 13 to 23 have been objected to in the final Office Action.

The Office Action stated that dependent claims 2 to 11 and 13 to 23 are objected to as being dependent from a rejected claim. Applicant disagrees with this objection because Claim 1 is not unpatentable over Ding et al. (abstract). The Office Action stated that, to overcome this objection, applicant should rewrite said claims in an independent form and include the limitations of the base claim and any intervening claim. Applicant thanks the Examiner for indicting allowability of the subject matter of the dependent claims. However, since applicant believes Claim 1 is allowable/patentable over Ding et al. (abstract), applicant also believes that this objection should be withdrawn.

The undersigned attorney thanks Examiner Shawquia Young and Primary Examiner Rebecca Anderson for the courtesy of the personal interview on July 7, 2009.

Claim 1 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Ding et al.* (see CAPLUS), which is an abstract, having a copyright date on it of 2008, of Chinese Published Patent (or Application) No. 1356334 A. Applicant continues to traverse this rejection.

During the interview the undersigned attorney asserted that the Ding et al. abstract supplied by the Examiner was not prior art against applicant's claimed invention because had benefit of priority going back to September 1, 2003. The Ding et al. abstract had a copyright date of 2008. The Primary Examiner asserted that it had the same date as the parent (publication) CN 1356334 A, namely, July 7, 2003. It seems

beyond reality that ACS prepares abstracts on the same day that journals, patents, etc., worldwide are published. The undersigned attorney disagreed because ACS had placed the copyright date of 2008 on the downloaded copy of Ding et al. (abstract) that the Examiner had supplied. Federal copyright law states that a notice of copyright shall contain, among other things, "the year of first publication" of the work. Hence, the ACS's insertion of the year 2008 in the notice of copyright means that the first year of publication is 2008, and hence Ding et al. on its face is not prior art to applicant's claimed invention. The burden of proof is upon the Examiner that the publication of Ding et al. was before applicant's priority date. There is no proof of record that the ACS created Ding et al. before applicant's priority date. The Examiner has not factually proven in the record the date (or year), other than 2008, that the ACS first published the Ding et al. abstract. The ACS's Ding et al. abstract is not the same as or identical to CN 1356334 A, so there is no basis in patent law (or logic) to give Ding et al. abstract the same publication date as CN 1356334 A. Note that MPEP 706.02, II, (Rev. Aug. 2006), says that an abstract can have a different effective publication date than the full text document.

The prior Office Action only cited Deng et al. abstract, so such prior Office Action was faulty. MPEP 706.02, II: says that it is "generally inappropriate" to rely only on an abstract without relying also on the underlying scientific document; and says that in "limited circumstances" it may be appropriate to make a rejection based wholly or in part only on the abstract. Hence, even with first Office Action it is seldom okay and proper to rely only on an abstract where the underlying (foreign language) scientific document is also prior art.

Note that MPEP 706.02. II, deals with reliance upon abstracts and foreign language documents in making a rejection.

The Examiner just cited CN 1356334 A as an alternative rejection reference in the obviousness rejection (in the AAF). The Primary Examiner said that therefore when applicant replied, the Examiner would withdraw the finality of the AAF. The undersigned had said that the finality of the present Office Action was premature because of the late citing of CN 1355334 A.

Note that Ding et al. is not the same as CN 1356334 A – it presents as Example 27 that which is Example 28 in CN 1356334 A. The Primary Examiner thought Example 27 in Ding et al. was a compilation of two examples of CN 1356334 A – this only supported the undersigned attorney's point.

The Office Action stated: that in Ex parte Bluestone, 135 USPQ 199, it was well established that the interchange of alkyl and hydrogen is obvious in and of itself and in addition secondary and tertiary amines are interchangeable; that, for example, it is obvious to prepare a beta amino ketone wherein the amine group is substituted with an alkyl group (i.e., methyl) using asymmetric hydrogenation in the presence of a transition metal complex of a chiral bidentate phosphine ligand when the art teaches a similar process wherein the amine group in the ketone is disubstituted with dimethyl with a reasonable expectation of success; that, specifically, a monomethyl substituted beta-amino ketone and a dimethyl substituted beta-amino ketone are considered homologues and are obvious absent unexpected results; that, therefore, it would have been prima facie obvious to one having ordinary skill in the art at the time the invention was made to prepare adjacent homologues by using asymmetric hydrogenation based

on the teachings of the prior art; and that a strong prima facie obviousness has been established. The undersigned attorney asserted that this CCPA decision was of no vitality because it did not follow the Supreme Court's Graham and KSR decisions that require the resolution of level of ordinary skill before any determination of obviousness could be made. The Examiner did not make such factual resolution in the record, so the undersigned attorney pointed out that the Section 103(a) rejection was defective ab initio. This also meant, the undersigned attorney asserted, that there could not be any factual/legal showing/establishment of prima facie obviousness. The undersigned attorney pointed out that methanol is deadly and ethanol is the basis of much human social and economic life. The Primary Examiner said that this involved the human body so it was not pertinent. The Primary Examiner's assertion merely shows that universal rules such as that involving homologues are of little or no value under Section 103(a).

Reconsideration, reexamination and allowance of the claims are respectfully
requested at present.

Respectfully submitted,

December 9, 2009
Date

Virgil H. Marsh
Virgil H. Marsh
Reg. No. 23,083

Fisher, Christen & Sabol
1156 15th St. NW
Suite 603
Washington, DC 20005
Tel.: 202-659-2000
Fax: 202-659-2015

